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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/806,487

03/23/2004

Greg Marik

31132.196

2793

46333 7590 04/12/2007
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EXAMINER

MILLER, CHERYL L

ART UNIT

PAPER NUMBER

3738

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/806,487

Applicant(s)

MARIK ET AL.

Examiner

Cheryl Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, 7, 9-18, 20-23 and 27-37 is/are pending in the application.
- 4a) Of the above claim(s) 6, 7, 10, 12-14, 20, 30 and 31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 9, 11, 15-18, 21-23, 27-29 and 32-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☒ Other: Attachments 1-3.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 22, 2007 has been entered.

Election/Restrictions

Claim 7 is being withdrawn by the examiner as being drawn toward a non-elected species. The first surface having flat and curved portions was not found in the figures 4-8.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 35-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 35 recites the limitation "the circular circumference" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 37 recites the limitation "the sidewall" in line 1. There is insufficient antecedent basis for this limitation in the claim.

It seems that claims 35-37 may have the incorrect dependencies.

Double Patenting

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 9, 11, 15-18, 27-29, and 32-37 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 9, 11, 14-18, 24-26, and 29-34 of copending Application No. 10/806,961. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are merely broader than the copending application claims. The present invention claims a joint prosthesis, wherein the copending application is more specific to an intervertebral joint prosthesis.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 9, 11, 15-18, 21-23, 27-29, and 32-37 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Ferree (US 7,048,764 B2, cited previously). Ferree discloses an implant (see fig. 1a; attachment 1) comprising first member (102), second member (108) and center member (106). Ferree discloses the radius of curvature of the first member (102) to be larger than the radius of curvature of the second member (108; col.2, lines 59-67; col.3, lines 1-3). Ferree discloses the center member (106) to have curvatures that are similar to the curvatures of the first and second members (congruent; col.2, lines 64-66). Ferree's implant inherently translates, due to the structure is the same as the applicant's and therefore will function the same. Ferree discloses the curvatures to be constant (spherical; col.2, lines 66-67). Ferree discloses the first curvature to be concave and the second curvature to be convex (see figs. 1a-1c). Ferree's implant is capable of being used as a shoulder, knee, or hip prosthesis (these claims are intended use language and Ferree's implant is capable of being placed in such a location). Ferree discloses the center member to have a third surface that is convex, and a fourth surface that is concave in the center portion and convex surrounding, see attachment 1.

Claims 1, 9, 15-18, 21-23, 27-29, and 32-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Marino et al. (US 2004/0133278 A1, cited previously). Marino discloses an implant (see fig.2) comprising first member (24), second member (22+26) and center member (28). Marino discloses the radius of curvature of the first member (24) to be larger than the radius of curvature of the second member (top surface of 26 seen as a smaller curvature than the

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surface of 24). Marino discloses the center member (28) to have curvatures that are similar to the curvatures of the first and second members (seen in fig.2 as congruent). Marino's implant translates (P0042, P0045). Marino discloses the first curvature (56) to be concave and the second curvature (46) to be convex (see fig.2). Marino's implant is capable of being used as a shoulder, knee, or hip prosthesis (these claims are intended use language and Marino's implant is capable of being placed in such a location). Marino discloses the center member (28) to have a third surface (52) that is convex, and a fourth surface (50) that is concave in the center portion and convex surrounding, see attachment 2.

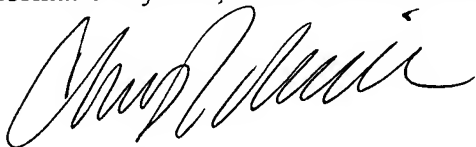
Claims 1, 9, 11, 15-18, 21-23, 27-29, 32-34, and 36-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Rogers et al. (US 2004/0002761 A1, cited in IDS). Rogers discloses an implant (see figs.21a, 21b, 22a, 22b) comprising first member (superior component), second member (inferior component) and center member (core member). Rogers discloses the radius of curvature of the first member (superior) to be larger than the radius of curvature of the second member (inferior; see fig.21b; P0357, P0358, P0145-P0163). Rogers discloses the center member to have curvatures that are similar to the curvatures of the first and second members (seen in figs.21b, 22b as congruent). Rogers implant translates. Rogers discloses the first curvature to be concave and the second curvature to be convex (see fig.21b). Rogers's implant is capable of being used as a shoulder, knee, or hip prosthesis (these claims are intended use language and Rogers implant is capable of being placed in such a location). Rogers discloses the center member to have a third surface that is convex, and a fourth surface that is concave in the center portion and convex surrounding, see attachment 3.

Conclusion

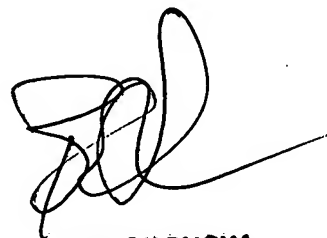
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Miller whose telephone number is (571) 272-4755. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4755. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Cheryl Miller



BRUCE SNOW
PRIMARY EXAMINER

Attachment #1 (marked up)

U.S. Patent

May 23, 2006

US 7,048,764 B2

